



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,677	02/25/2002	Whitney Hilton Stewart	025213-9075-00	6623

23409 7590 08/05/2009  
MICHAEL BEST & FRIEDRICH LLP  
100 E WISCONSIN AVENUE  
Suite 3300  
MILWAUKEE, WI 53202

EXAMINER
----------

TRAN, HAI

ART UNIT	PAPER NUMBER
----------	--------------

3694

MAIL DATE	DELIVERY MODE
-----------	---------------

08/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/082,677	<b>Applicant(s)</b> STEWART ET AL.	
	<b>Examiner</b> HAI TRAN	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is the communication in response to the Amendment/Remarks filed on April 23, 2009 for application, titled: "Electronic Payment and Authentication System with Debit and Identification Data Verification and Electronic Check Capabilities".
2. Claims 48-76 remain pending in this application and have been examined.

### ***Priority***

3. This application claims the benefit of U.S. Provisional Patent Application No. 60/271,156, filed on February 23, 2001.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 76 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Claim 76 recites method directed to purely mental steps. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876); *Ex parte Langemyr* (BPAI No. 2008-1495, May 28, 2008), *In re Bilski*, \_\_ F.3d \_\_ (Fed. Cir. 2008)(en banc). If

Art Unit: 3694

neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Thus, to qualify as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state.

7. In the present case, the claim recites a method that is not tied to a particular apparatus (i.e. computer, processor) to transform the subject matter. Hence, the claim is directed to a mental process which is non-statutory under 35 USC 101.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 48-76 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 48-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goeller (U.S. Patent Application Publication No. 2002/0178112) (Goeller") in view of Morgan et al. (U.S Patent No. 6,073,140) ("Morgan").

11. **With respect to claim 76**, Goeller teaches a method of conducting a debit validation of a consumer involved in a debit transaction, the method comprising:

receiving a request from a merchant to validate debit data of the consumer involved in a debit transaction (see Goeller, par. 49-52, Figure 3);

receiving transactional debit data that is to be validated (see Goeller, par. 54-58, Figure 5);

retrieving a consumer key based on at least a portion of the transactional debit data, the consumer key linking debit data from a plurality of data sources (see Morgan, col. 3, lines 35-50);

analyzing the debit data associated with the consumer key (see Goeller, par. 61-74, Tables 4 & 5 “Response Message Fields”, “Response Codes”, Figures 6A-C); and

generating a response message to the merchant, wherein the response message is indicative of one of a first condition and a second condition, wherein the first condition is a validation of the debit data, and further wherein the second condition is a lack of validation of the debit data of the consumer (see Goeller, par. 67, Table 4 & 5, Figure 6/elements 474, 482).

Goeller teaches a method and system that converts paper checks online and in real-time into an electronic funds transaction, but is silent on the data structure updating and enhancement. However, Morgan teaches a method and system using the persistent keys linking to each data structure that is disclosed (see Morgan, Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the online POS check service as taught by Goeller with the

Art Unit: 3694

teachings of the data creation and updating using the persistent keys as taught by Morgan to offer an improved system and method that is more efficient for data updating and enhancement to customers. The motivation is simply to provide a method and system that is more cost effective for data enhancement (see Morgan, col. 3, lines 14-30).

12. **With respect to claim 48**, Goeller teaches a debit data validation system for a network, the system comprising:

- a calling application configured to receive a request to validate debit data from a merchant, and receive transactional debit data that is to be validated (see Morgan, col. 8, lines 55-64; Figure 2/element 210, 214);

- a debit data search engine including a keying module and a matching module, wherein the debit data search engine is configured to receive the transactional debit data from the calling application, and process the transactional debit data to identify a consumer key (see Morgan, col. 12, lines 25-61; Figure 2/element 220 “central database manager matches data”); and

- a debit data warehouse including stored debit data, wherein the debit data warehouse is configured to retrieve the stored debit data associated with the consumer key wherein the stored debit data is representative of at least one consumer, and further wherein the consumer key links the stored debit data gathered from a plurality of data sources (see Morgan, col. 9, lines 15-24; Figure 2/element 224); and

wherein the calling application is further configured to process the stored debit data, determined whether to allow the debit transaction, and generate a response message to the merchant with the determination (see Morgan, col. 12, lines 25-61; Figure 2/element 220). One of ordinary skill in the art would have combined the teachings of Goeller with Morgan to offer an improved system and method that is more efficient for data structure updating and enhancement.

13. **With respect to claims 49-53**, Goeller does not teach such features. However, Brown teaches wherein the keying module performs a keying process, and further wherein the keying process includes a standardization component, a validation component, and a matching component (see Morgan, col. 13, lines 7-22; Figure 3),

further comprising a converter is adapted to be coupled to at least one of the debit data search engine and the debit data warehouse (see Morgan, Figure 2/element 226), further wherein the converter is coupled to at least one data source, and further wherein the at least one data source includes raw debit data representative of the at least one consumer (see Morgan, figure 2/element 220);

wherein the converter performs parsing of the raw debit data and parsing includes breaking a single data field into a number of representative data fields (see Morgan, col. 10, lines 55-27 of col. 11); bursting of the raw debit data and bursting includes separating a joint account name into at least two representative names (see Morgan, Figure 3 and 4 and associated description); and including a geographic coder adapted to correct at least one of a street name, a city, a state, a zip code (see Morgan,

Art Unit: 3694

Figure 3 and 4 and description). One of ordinary skill in the art would have combined the teachings of Goeller with Morgan to offer an improved system and method that is more efficient for data structure updating and enhancement.

14. **With respect to claims 54-56**, Goeller teaches a system as claimed in claim 50, wherein the raw debit data includes data from at least one of a checking account opening, a checking account closing, a savings account opening, a savings account closing, a checking account collection, an overdraft, a check order, a returned check transaction, a check printing order, an account inquiry, a retail transaction, an ATM transaction, an automated clearinghouse transaction, and an Internet transaction (see Goeller, Table 4, par. 55 see “routing number, account number, check serial number”),

wherein the raw debit data includes attributes associated with the at least one consumer, and further wherein the attributes include at least one of a name, an address, a SSN, a driver's license number, a driver's license state, a bank account number, a home phone number, a work phone number, and an MICR (see Goeller, Table 1), and

wherein the raw debit data from the at least one data source is utilized only if it includes at least two of the attributes (see Goeller, Table 1).

15. **With respect to claim 57**, Goeller does not explicitly teach such feature. However, Morgan teaches a system as claimed in claim 49, wherein the standardization component standardizes the raw debit data into a consistent format (see Morgan,



Art Unit: 3694

Figures 3-5 and description). One of ordinary skill in the art would have combined the teachings of Goeller with Morgan to offer an improved system and method that is more efficient for data structure updating and enhancement.

16. **With respect to claim 58**, Goeller does not expressly teach such feature.

However, Morgan teaches a system as claimed in claim 49, wherein the validation component checks the raw debit data against existing reference files to detect at least one of bad data and incorrect data (see Morgan, Figures 3-5 and description). One of ordinary skill in the art would have combined the teachings of Goeller with Morgan to offer an improved system and method that is more efficient for data structure updating and enhancement.

17. **With respect to claims 59-63**, Goeller does not teach such matching condition feature. However, Morgan teaches a system as claimed in claim 49, wherein the matching component matches the raw debit data against the stored debit data to determine the first condition and second condition (see Morgan, Figures 3-5 and description). One of ordinary skill in the art would have combined the teachings of Goeller with Morgan to offer an improved system and method that is more efficient for data structure updating and enhancement.

18. **With respect to claim 64**, Goeller does not expressly teach such features.

However, Morgan teaches wherein the at least one consumer key is thirteen bytes long

Art Unit: 3694

with the first three bytes including a partitioning key, wherein the partitioning key determines the physical partition the stored debit data the at least one consumer key is representative of is located in (see Morgan, Figure 5 and 6 and description). One of ordinary skill in the art would have combined the teachings of Goeller with Morgan to offer an improved system and method that is more efficient for data structure updating and enhancement.

19. **With respect to claim 65**, Goeller teaches wherein the at least one consumer key is identified by at least one of a name and an address (see Goeller, Table 1. Morgan, Figure 4 and description).

20. **With respect to claims 66-75**, these claims correspond to claims 55-63 and have the same limitations. Hence, they are rejected under the same rationale provided in claims 55-63.

### ***Conclusion***

21. Claim 48-76 are rejected.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone

Art Unit: 3694

number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./

Examiner, Art Unit 3694

/Mary Cheung/

Primary Examiner, Art Unit 3694